

REMARKS

Claims 124-129 are pending in this application. Claims 1-123 have been canceled without prejudice or disclaimer in the Preliminary Amendment filed January 2, 2004. Claims 125-129 have been withdrawn from consideration in the Office Action mailed June 23, 2006, as not reading on the elected species. Applicants appreciate the acknowledgement that the elected species is allowable.

Claim 124 has been amended to indicate the stereochemistry of two chiral centers of the claimed amino alcohols. In particular, the stereochemistry of the carbon atom bearing the substituent R² is now indicated, in addition to the stereochemistry of the adjacent carbon atom bearing the hydroxyl group. Support for the claimed stereochemical configuration about these two carbon atoms is found throughout the specification. See, for example, the sulfonyl derivative structures shown on page 16, the compounds prepared in Examples 1-14, and numerous other species bearing these chiral carbon atoms.

Accordingly, no new matter is added.

Information Disclosure Statement (IDS) filed January 2, 2004

A review of the returned and initialed forms PTO-1449 and PTO/SB/08 indicates that several of the references cited in the IDS filed January 2, 2004 were crossed out and/or not initialed. It is presumed therefore that these non-considered references are missing from the files of prior applications, relied upon for priority, in which copies of the references were initially provided.

The missing references, which have not yet been considered, will be cited in a Supplemental IDS as soon as they become available.

Supplemental Application Data Sheet (ADS)

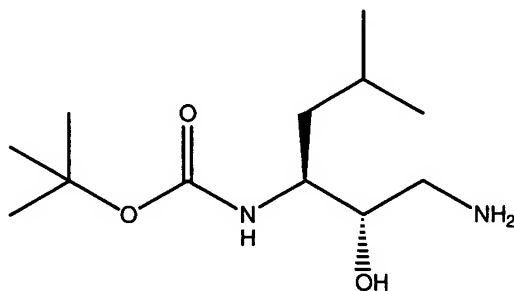
The Supplemental ADS accompanying this response corrects a typographical error in the priority information. In particular, the serial number of the application that issued as U.S. Patent No. 5,639,769 has been correctly identified as 08/587,688, instead of 08/857,688.

The Rejection of Claim 124 under 35 U.S.C. § 102(b)

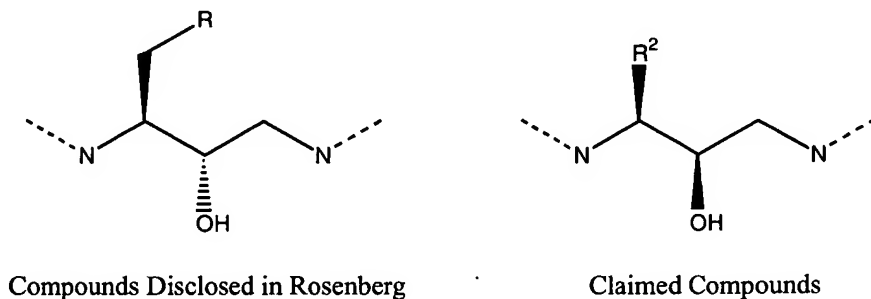
Claim 124 has been rejected under 35 U.S.C. § 102(b) as anticipated by Rosenberg *et al.*, J. MED. CHEM. (1987) 30:1224-1228 ("Rosenberg"). Applicants respectfully traverse this rejection insofar as it applies to claim 124 as now amended.

For a claim to be anticipated, every element and limitation of the claimed invention must be found in a single prior art reference. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286, 1291 (Fed.Cir. 2001). (emphasis added). Rosenberg fails to meet this legally required standard for anticipation, at least because Rosenberg depicts amino alcohol compounds having a stereochemical configuration that is different from the claimed compounds.

The Office Action points specifically to compound 3a disclosed on page 1225 of Rosenberg. Rosenberg identifies this compound as (2S,3S)-1-Amino-2-hydroxy-3-[(*tert*-butyloxycarbonyl)-amino]-5-methylhexane, acetic acid salt (see page 1226, first full paragraph). In its free (*i.e.*, non-salt) form, this compound has the structure



Claim 124 as amended does not read on this compound. This is clear from the following side-by-side comparison between the corresponding carbon atoms, for which the stereochemistry is specifically indicated, of the compounds (1) disclosed in Rosenberg and (2) claimed:



The disclosure of Rosenberg pertains to renin inhibitors. As Rosenberg acknowledges, these compounds have particular “stereoelectronic requirements.” See page 1224, 2nd paragraph. The stereochemistry of these compounds differs from that of the retroviral protease inhibitors (and precursors) which Applicants have disclosed and claimed. Consequently, Rosenberg fails to describe, or even suggest, the claimed compounds having the indicated stereochemistry about the adjacent carbon atoms bonded to the R² and –OH substituents.

Reconsideration and withdrawal of the rejection is respectfully requested.

Rejoinder of Claims 125-129 (M.P.E.P. § 821.04)

Claims 125-129, by virtue of their dependency on claim 124, are of the same scope and therefore comply with the requirements under M.P.E.P. § 821.04(a) for rejoinder. Upon a finding that elected claim 124 is allowable, the non-elected claims 125-129 must be rejoined. See M.P.E.P. § 821.04(a).

Applicants therefore respectfully request, upon a finding that elected claim 124 is allowable, rejoinder of non-elected claims 125-129.

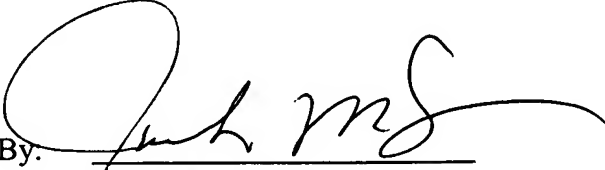
CONCLUSION

In view of the above amendments and remarks, pending claims 124-129 of this application are believed to be in condition for allowance. Acknowledgement of the same is respectfully requested.

This response is believed to completely address all of the substantive issues raised in the Office Action dated June 23, 2006.

Respectfully submitted,

Date: September 25, 2006

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